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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO:
09/708,038	11/08/2000	Zaheer Khalfan	1084-7/MBE	8013

7590                    06/18/2003

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CANADA

EXAMINER
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NGUYEN, TUAN N

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/708,038	Khaljan
Examiner	Art Unit	
Tuan Nguyen	3653	



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1)  Responsive to communication(s) filed on 4/4/03

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

4)  Claim(s) 1-22 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-6, 8-13 and 15-21 is/are rejected.

7)  Claim(s) 7, 14 and 22 is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.

2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- |  |  |
|--|--|
| 15) <input type="checkbox"/> Notice of References Cited (PTO-892)                              | 18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ | 20) <input type="checkbox"/> Other: _____                                    |

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### **DETAILED ACTION**

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-6 and 8-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Howarth et al.

Howarth et al. disclose a detection device and a method for differentiating between a paper product 12 containing less than a selected amount of groundwood contaminants and a material containing more than the selected amount of groundwood contaminants (column 3, lines 56-62).

Note that the groundwood contaminants are inherently the amount of lignin which causes the paper product having different colors other than white color . The device and method comprise a light source 20 and 22 having an ultraviolet component (column 2, lines 3-10) positioning to emit light to strike the material; a detector 32 for detecting ultraviolet light and generating an electrical signal proportional to an intensity of detected ultraviolet light; an optical filter 30 to eliminate components of diffusely reflected light outside of the ultraviolet range; an instrument 36 for measuring a level of the electrical signal.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 15-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howarth et al. in view of McGarvey.

Howarth et al. have been discussed in paragraph 2 above. However, Howarth et al. do not have a conveyor and do not have an ejection device.

McGarvey discloses an apparatus and a method for detecting and sorting flat products such as potato chips comprising a conveyor 18 for conveying the products and an ejection device 38 having a plurality of air nozzles.

It would have been obvious to one skill in the art to modify the device and method of Howarth et al. to have a conveyor and an ejection device as taught by McGarvey. The conveyor is for conveying the products to an inspection station and the ejection device is for separating the products into acceptable and unacceptable products.

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6. Claims 7, 14 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Applicant's arguments filed on April 04, 2003 have been fully considered but they are not persuasive.

Responding to applicant's remarks, applicant has alleged that the reference of Howarth et al. does not relate to pre-cycled paper sorting; and also has alleged that the present invention sorts paper of the same color (white). However, the Examiner respectfully disagrees. None of the claims recite "pre-cycled paper sorting" nor "sorts paper of the same color". Applicant also has alleged that there is no purpose of UV light in Howarth et al.. Again, the Examiner disagrees. It is reasonable to assume the light detector of Howarth et al. detects UV light as well as the visible light. No where in Howarth et al. recites the detector NOT detecting UV light.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to Examiner Tuan Nguyen at telephone number (703) 308-3664.

*Tuan Nguyen*  
TUAN N. NGUYEN  
PRIMARY EXAMINER  
6/16/03

tnn,

June 16, 2003.